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10/714,097	11/14/2003	Scott C. Harris	BARCODE-D1	9523
23844	7590	10/04/2005	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/714,097

Applicant(s)

HARRIS, SCOTT C.

Examiner

Daniel I. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-22, 24-26, 28-31 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22, 24-26, 28-31 and 38-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt is acknowledged of the Amendment received on 11 July 2005. Claims 18-22, 24-26, 28-31, and 38-42 are pending. This is a Non-Final action, as the Examiner has made adjustments to the rejections to place them in better form.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly amended claim 19 recites the communication describes a time and place of some event includes information about an item for sale and a way to get more information about the item. The Examiner notes that a communicating including all such limitations was not described in the specification.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 18, 24, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al. (US 6,655,597).

Re claim 18, Swartz et al. teaches forming a communication; forming a bar code as part of the communication, the bar code including scannable information, which when scanned, forms information that is supplemental to the communication through "A particular implementation of the present invention allows the consumer to subsequently download the information stored in the reader pen 90 in a manner described in more detail below. In particular the information can be downloaded to a personal computer or other access point to a computer or data network. The downloaded information can then be used in various different manners. For example the product can be ordered or additional information concerning the product can be accessed. A particular implementation proposed under the present invention is that the bar code symbol accompanying the advertisement contains sufficient information for the personal computer or access point to the computer network to access a site on the Internet (or comparable data storage system). This site can contain additional information concerning the advertised product, information concerning related products, price information, cross-references to further related sites, and the capability of ordering and paying for the product. This greatly simplifies the purchasing process and also ensures that the consumer does not forget a product which has caught his attention" (col 7, lines 41+). Re claim 24, the barcode represents an address (website address) to additional information as discussed above. Re claim 38, the limitations have

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been discussed above where a barcode is decoded to obtain information to access a website (internet).

4. Claims 18 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Buckley et al. (US 6,446,871).

Buckley et al. teaches forming a communication; forming a bar code as part of the communication, the bar code including scannable information, which when scanned, forms information that is supplemental to the communication (FIG. 5) where a user scans a barcode from a periodical/advertisement (communication that the code is part of), and supplemental information is provided through the web address that is fetched.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 17 above.

The teachings of Swartz et al. have been discussed above.

Though Swartz et al. is silent to accessing a publicly available database to obtain additional information, the Examiner notes that it has been taught above that a barcode of an advertised item can be scanned and used to direct a user to a website for further information. Accordingly, it would have been well within the skill in the art to include a database linked to the code, such as a manufacturers website, that is accessed upon scanning of the barcode, to obtain further product information. Such modification would be obvious in order to provide additional data/information about a product, to a customer, where the data is stored in a conventional and easily accessible database format, which is commonly accessible via the Internet, for example, by the public.

6. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as discussed above, in view of Paul et al.

The teachings of Swartz et al. have been discussed above, as a barcode on a communication.

Swartz et al. is silent to the code containing first and second parts where the second part has more information than the first.

Paul et al. teaches a dual type barcode with a first part that is interpreted by a first bar code scanning process to obtain first information and a second part which is interpreted by a second bar code scanning process to obtain second information that has more information than the first information (abstract). Re claim 29, Paul et al. teaches a linear first part and non-linear

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second part (glyph which can include various types, col 4, lines 56+). Further, the examiner notes that it is well known and conventional to use non-linear barcodes for secondary encoded information in order to store more data, for example.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al. with those of Paul et al.

One would have been motivated to do this to encode more information in a barcode.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al./Paul et al., further in view of Lemelson et al.

The teachings of Swartz et al./Paul et al have been discussed above.

Swartz et al./Paul et al. are silent to scanning in different directions.

Lemelson et al. teaches scanning in different directions (abstract).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al./Paul et al. with those of Lemelson et al.

One would have been motivated to do this to provide a means to efficiently read out data, store a dense amount of data, and also be downwardly compatible.

8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al./Paul et al., further in view of Kaufman et al.

The teachings of Swartz et al./Paul et al. have been discussed above.

Swartz et al./Paul et al. is silent to second information being obtained from a color/grayscale.

Kaufman et al. teaches color being used to store information in a barcode (claims 1-8+).

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At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al./Paul et al. with those of Kaufman et al.

One would have been motivated to do this to have a barcode (colored) to provide robustness and reliability, reduced errors, alternative identification means, etc.

9. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al.

The teachings of Swartz et al. have been discussed above, where a scanning of a barcode is used to access a website. Re claims 39-40, though Swartz is silent to a 2-D and 3-D barcode, the Examiner notes that such barcodes are well known and conventional for storing more data, and accordingly, their use is well within the skill in the art for encoding a greater amount of data, and therefore an obvious expedient. Re claim 41, it has been discussed above that it is well known and conventional for barcodes to include different parts that include different data, in order to encode different types of information (additional information). Accordingly, encoded website information in one of those parts is well within the skill in the art, in order to encode website information, for linking purposes, for example, supplemental to a different information encoded in a first part.

10. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 38 above, further in view of Knowles (US 6,622,917).

The teachings of Swartz et al. have been discussed above.

Swartz et al. teaches a barcode associated with an advertisement, but is silent to receiving an email that includes an image of a barcode associate with an advertisement and decoding the image to form information.



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Re claim 42, Knowles teaches receiving an email including barcodes, printing out the barcodes and decoding the barcodes to form information (col 4, lines 23+). This is broadly interpreted to including receiving representations/images of barcodes via email.

At the time the invention was made, it would have been obvious to combine the teachings of Swartz et al. with those of Knowles et al. in order to provide a means for electronically obtained barcodes to be printed and used.

11. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., as discussed above, in view of Knowles (US 6,622,917).

The teachings of Buckley et al. have been discussed above.

Buckley is silent to using a computer to scan the barcodes to access a database with the address.

Re claims 25-26, Knowles teaches the limitations (col 4, lines 62+), where Knowles teaches using a computer which has scanned the bar code to access a public database with the address and to obtain additional information (via the Internet).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Buckley et al. with those of Knowles.

One would have been motivated to do this in order to provide a communication in a well that allows users to access specific/details information off the Internet for convenience.

12. Claims 28-29, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., as discussed above, in view of Paul et al.

The teachings of Buckley et al. have been discussed above, including a barcode on a communication.

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Buckley et al. is silent to a dual bar code.

Re claim 28, Paul et al. teaches a dual type barcode with a first part that is interpreted by a first bar code scanning process to obtain first information and a second part which is interpreted by a second bar code scanning process to obtain second information that has more information than the first information (abstract). Re claim 29, it has been discussed above that the first part is a linear barcode and the second part is not, as it is a glyph which can include various types, (col 4, lines 56+). Further, the examiner notes that it is well known and obvious to use non-linear barcodes for secondary encoded information. Re claim 41, it has been discussed above that it is well known and conventional for barcodes to include different parts that include different data. Accordingly, encoded website information in one of those parts is well within the skill in the art, in order to encode website information, for linking purposes, for example, thus providing information that is supplemental to a first part.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Buckley et al. with those of Paul et al.

One would have been motivated to do this to encode more information in a barcode/communication.

17. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al./Paul et al., further in view of Lemelson et al.

The teachings of Buckley et al./Paul et al have been discussed above.

Buckley et al./Paul et al. are silent to scanning in different directions.

Lemelson et al. teaches scanning in different directions (abstract).

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At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Buckley et al./Paul et al. with those of Lemelson et al.

One would have been motivated to do this to provide a means to efficiently read out data, store a dense amount of data, and also be downwardly compatible.

18. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al./Paul et al., further in view of Kaufman et al.

The teachings of Buckley et al./Paul et al. have been discussed above.

Buckley et al./Paul et al. is silent to second information being obtained from a color/grayscale.

Kaufman et al. teaches color being used to store information in a barcode (claims 1-8+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Buckley et al./Paul et al. with those of Kaufman et al.

One would have been motivated to do this to have a barcode (colored) to provide robustness and reliability (reduced errors, alternative identification means, etc.).

19. Claims 39-40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al.

The teachings of Buckley et al. have been discussed above, re claim 17, where a scanning of a barcode is used to access a website. Re claims 39-40, though Buckley et al. is silent to a 2-D and 3-D barcode, the Examiner notes that such barcodes are well known and conventional for storing more data, and accordingly, their use is well within the skill in the art for encoding a greater amount of data, and therefore an obvious expedient.

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20. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., as discussed above, in view of Knowles.

The teachings of Buckley et al. have been discussed above.

Buckley et al. teaches a barcode associated with an advertisement, but is silent to receiving an email that includes an image of a barcode associate with an advertisement and decoding the image to form information.

Re claim 42, Knowles teaches receiving an email including barcodes, printing out the barcodes and decoding the barcodes to form information (col 4, lines 23+). This is broadly interpreted to including receiving representations/images of barcodes via email.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Buckley et al. with those of Knowles.

One would have been motivate to do this to provide convenience to the user by permitting electronic communicated codes to be printed and used.

### ***Response to Arguments***

21. Applicant's arguments filed 21 July 2005 have been fully considered but they are not persuasive. The Examiner notes that Buckley teaches a barcode as part of the communication as discussed above. The Examiner additionally notes that printed matter is not patentable. Namely, what is printed on a communication (event, advertisement, etc.), does not distinguish it from prior art of a similar structure, since it would only depend on the intended use of the communication and the information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the

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invention from the prior art in terms of patentability; In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of sheet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate, which is required for patentability.

#### ***Additional Remarks***

22. The Examiner notes (see Williams US 5,920,062 and Oakeson et al. US 6,398,117, for examples of first and second parts of a barcode.
23. The Examiner notes that Knowles teaches 2-d/3-d encoding for increased data storage.
24. As claims 18-22, 24-26, 28-31, and 38-42 are pending, the previous oath/declaration filed by the Applicant is not persuasive in addressing the claimed limitations of the currently pending claims.

#### ***Conclusion***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW

9/23/05

Daniel Walsh